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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,796	03/22/2004	James F. McGuckin JR.	1267	1069

EXAMINER
SONNETT, KATHLEEN C

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3731	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,796

Applicant(s)

MCGUCKIN ET AL.

Examiner

Kathleen Sonnett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-25 is/are allowed.
- 6) ☒ Claim(s) 18-20 and 26 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. The examiner indicated that claims 18-26 were allowable in the office action dated 3/15/2007. Additionally, the examiner contacted Neil Gershon on 6/20/2007 to discuss an examiner's amendment to claim 26 to put the application into condition for allowance. However, after further search and consideration, claims 18-20 and 26 have been rejected in view of Weldon (U.S. 6,468,290), Bosma (U.S. 6,989,021), and Palmer (U.S. 5,782,748) as discussed below. Claims 21-25 are allowable.
2. The amendment to claim 26 discussed by the examiner and applicant on 6/20/2007 has not been entered and therefore appears as an objection to claim 26 with the suggested changes included in the rejection.
3. Regarding claim 18: Looking at the retrieval region of Bosma (U.S. 6,989,021) in fig. 3, the filter retrieval region can be considered to comprise two ears. Element 22 then comprises two hooks, each hook comprising a single ear. Therefore, Bosma discloses a retrieval region having a hook with a single ear. It is suggested that a limitation of the filter having only one hook be added to distinguish the instant invention from the prior art of Bosma.
4. Regarding claim 20: If the retrieval region of Bosma in fig. 3 is considered two hooks, each comprising one ear, then the retrieval region includes a hook on only one side of the longitudinal axis. This does not exclude the presence of other hooks.

Claim Objections

5. Claim 26 is objected to because of the following informalities: claim 26 should read "The vessel filter of claim 20, wherein the vessel engaging structure comprises vessel engaging hooks extending....". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 20 and 26** are rejected under 35 U.S.C. 102(e) as being anticipated by Bosma et al. (U.S. 6,989,021). Bosma et al. discloses a vessel filter comprising a first region and a second region, the first region including a filtering section for capturing particles and having a first transverse dimension, the second region including a mounting section for mounting the filter within the vessel, the mounting section having a second transverse dimension greater than the first transverse dimension and including vessel engaging structure (26) to retain the filter, the first region further including a retrieval region (18) having a longitudinal axis that includes a hook on only one side of the longitudinal axis at a proximal end thereof.

8. Element (22) is being considered two hooks (see fig. 3). Looking at one of the hooks, the hook is on only one side of the longitudinal axis of the retrieval region. As discussed above, the claim does not limit the retrieval region to only one hook. The hook has a cutout exposing an internal annular surface (Fig. 3 and 4, "22"). The hook is meant to ease retrieval by a retrieving device and is therefore dimensioned to receive a portion of a retrieval sheath, such as a hook. The hook also has an inner surface exposed and dimensioned to receive a portion of a retrieval device since it is provided for the purpose of being snared with a retrieving device.

9. Regarding claim 26, Bosma discloses vessel engaging hooks (barbs 26).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weldon et al. in view of Bosma et al. (U.S. 6,989,021). Weldon et al. disclose a vessel filter comprising a first region at the first end portion and at the second end region, the first region including a filtering section for capturing particles and having a first transverse dimension at a first terminal end of the filter, the second region including a mounting section for mounting the filter within the vessel, the mounting section having a second transverse dimension at the second terminal end of the filter, the second dimension being greater than the first transverse dimension and including vessel engaging structure (27) to retain the filter. Looking at fig. 3A, the first region is being considered the "top" half of the filter and the second region the "bottom half" (examiner is designating 21 to define the "top" of the filter only for illustration purposes). Weldon et al. fails to disclose that the first region further including a retrieval region (18) on the first region that includes a hook and the particulars of the hook.

12. However, Bosma discloses that it is old and well known in the art to employ hooks on the end of a filter. Bosma discloses a hook that has a cutout exposing an internal annular surface (Fig. 3 and 4, "22"). As is well known in the art, hooks are employed to ease retrieval of a filtering device by a retrieving device. The hook is meant to ease retrieval by a retrieving device

and is therefore dimensioned to receive a portion of a retrieval sheath, such as another hook (col. 5 ll. 8-11). The retrieval region of Bosma (see fig. 3) can be considered two hooks, each having a single ear. Therefore, Bosma discloses a hook having a single ear and there is no language in the claim that limits the filter to having only one hook. It would have been obvious to one of ordinary skill in the art to modify Weldon et al. to have a retrieval region including a hook having a cutout exposing an internal annular surface, the hook being only one side of the longitudinal axis as made obvious by Bosma in order to make retrieval of the device easier.

13. Regarding claim 19, the retrieval region includes a radiused region having first and second curved surfaces extending distally inwardly as seen in Fig. 3 and 4.

14. Alternatively, **claims 18-20 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weldon et al. in view of Bosma et al. (U.S. 6,989,021) and Palmer (U.S. 5,782,748). Weldon et al. disclose a vessel filter comprising a first region at the first end portion and at the second end region, the first region including a filtering section for capturing particles and having a first transverse dimension at a first terminal end of the filter, the second region including a mounting section for mounting the filter within the vessel, the mounting section having a second transverse dimension at the second terminal end of the filter, the second dimension being greater than the first transverse dimension and including vessel engaging structure (27) to retain the filter. Looking at fig. 3A, the first region is being considered the "top" half of the filter and the second region the "bottom half" (examiner is designating 21 to define the "top" of the filter only for illustration purposes). Weldon et al. fails to disclose that the first region further including a retrieval region (18) on the first region that includes a hook and the particulars of the hook.

15. As is well known in the art, hooks are employed to ease retrieval of a filtering device by a retrieving device and Bosma teaches that retrieval regions can include a hook that has a cutout

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exposing an internal annular surface. The hook is meant to ease retrieval by a retrieving device and is therefore dimensioned to receive a portion of a retrieval sheath, such as another hook (col. 5 ll. 8-11). Palmer teaches an alternative cutout bayonet type fitting (see fig. 5) that forms a releasable interlocking mechanism between two pieces of a medical device. Such a fitting has a hook on only one side of the longitudinal axis and a curved wall spaced axially from the hook (for example, inner wall of lumen) to provide a camming surface, the hook having an inner surface exposed and dimensioned to receive a portion of a retrieval device. The hook has a single ear (see fig. 5) and is on only one side of the longitudinal axis of the retrieval region. Therefore, it would have been obvious to one of ordinary skill in the art to modify Weldon et al. to have a retrieval region including a hook having a cutout exposing an internal annular surface, the hook being only one side of the longitudinal axis as made obvious by Bosma and Palmer in order to make retrieval of the device easier.

16. Regarding claim 19, the retrieval region includes a radiused region having first and second curved surfaces extending distally inwardly as seen in Fig. 3 and 4.

17. Regarding claim 26, the hooks extend from the mounting section and are positioned at a terminal end of the filter as seen in fig. 2a.

Allowable Subject Matter


Claims 21-25 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GLENN K. DAWSON
PRIMARY EXAMINER

KCS 6/26/2007